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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,716	03/26/2002	Yufu Sagara	2002-0068A	6726

513 7590 06/30/2003

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EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 06/30/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,716

Applicant(s)

SAGARA ET AL.

Examiner

Celia Chang

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 04/16/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 23 and 24 is/are rejected.
- 7) ☐ Claim(s) 1,2 and 4-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other:

DETAILED ACTION

1. Applicant's election without traverse of Group I, claims 2, 6, 8, 20 with example 12 as the elected species in Paper No. 9, dated April 23, 2003 is acknowledged.

Claims 1, 4, 5, 7, 9, 10-14, 20 and 23-24 reading on the elected compounds will be prosecuted together with the election. Claims 3, 15-22 being drawn to the non-elected invention, are withdrawn per 37 CFR 1.142 .

The subject matter being examined in claims 1-2, 4-14, 20, and 23-24 are formula being drawn to claim 2, s=1. It is recommended that the non-elected invention be deleted from the claims.

2. Claims 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of claims 23-24 are ambiguous since the term "treating agent" is unclear. Is the term referring to a composition or method of treating? The claims are drawn to a hybrid format.

If the claims are composition claims, then the quantity of the active ingredient, i.e. a muscarinic M3 receptor antagonistic effective amount, together with carrier of the compositions should be incorporated.

If the claims are method for treating diseases, then the particular disease, steps, sited of administrating and dosage should be incorporated.

In addition, there is an "[" at line 2 on page 187 which seems to be confusion whether some text is intended to be deleted since the other bracket was not found.

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3. Claims 1-2, 4-14, 23-24 are objected to because it contains nonelected inventions. The elected invention wherein claims 1-2, 4-14, 23-24 are formula being drawn to claim 2, s=1 is allowable when the non-elected inventions are deleted from the claims.

The closest prior art is found in WO 95/06635 wherein tritylsubstituted piperidines were disclosed to have muscarine M3 receptor activity (p.82, compound 8). However, no suggestion was made to insert multiple chain length as the instant claims between the trityl moiety and the piperidine moiety.

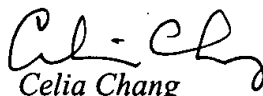
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner can be reached by facsimile at (703) 308-7922 with courtesy voice message supra.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

OACS/Chang
June 26, 2003


Celia Chang
Primary Examiner
Art Unit 1625